



The Intellectual Property Law Section of  
the State Bar of California presents the  
**32<sup>nd</sup> Annual Intellectual Property Law Institute**

# KSR v. Teleflex, Inc.

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## How did we get to KSR?

- In 1791, Thomas Jefferson complained that too many patents were being sought on “trifles.”
- Jefferson proposed amending the 1790 Patent Act to add, as a defense to a patent, that the claimed invention “is so unimportant and obvious that it ought not be the subject of an exclusive right.”
- *Hotchkiss v. Greenwood*, 52 U.S. 248 (1850),
  - Patent for door knobs of potter’s clay or porcelain
  - Prior door knobs were made in the same fashion, but out of metal or wood
- The Supreme Court concluded that the substitution of materials was an act “destitute of ingenuity” without citing a single case



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# How did we get to KSR?

- At various times in the hundred years prior to the 1952 Act, the Court imposed various subjective tests, such as the “inventive genius” test, the “creative faculties” test, or the “flash of creative genius” test.
- 35 USC 103 (a) was codified in the 1952 Act:
  - “A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said invention pertains. Patentability shall not be negated by the manner in which the invention was made.”





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# How did we get to KSR?

- *Graham v. John Deere*, 383 U.S. 1 (1966)
  - Non-obviousness is a new third statutory requirement for patentability.
  - Scope and content of prior art are determined
  - Differences between the prior art and the claims at issue are ascertained
  - The level of ordinary skill in the art is determined
  - Secondary considerations (“such as” commercial success, long-felt but unsolved needs, failure of others, etc.) “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.”
  - PTO instructed to “strictly adhere” to 1952 Act.
- CAFC created in 1983
  - *In re Sernaker*, 702 F.2d 989 (Fed. Cir. 1983), adopts the first incarnation of the “teaching-suggestion-motivation” test



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# KSR Case History

- Teleflex, exclusive licensee for US Patent No. 6,237,565 sues KSR Inc.
- Claim 4 of the patent was at issue and describes a mechanism for combining an electronic sensor with an adjustable pedal so that the pedal's position can be transmitted to a computer that controls the throttle for the vehicle's engine
- The District Court granted summary judgment after determining that the claim at issue (Claim 4) is obvious
- The District Court compared the teachings of the prior art with the patent claims and found little difference except that the use of a sensor to detect the pedal's position and transmit it to the computer



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## KSR Case History

- CAFC reversed due to improper application of the TSM test
- Under the TSM test one can combine prior art teachings, when the “motivation or suggestion” to combine the prior art references is present in the prior art, nature of the problem solved or knowledge of those ordinary skilled in the art”
- CAFC reasoned that the prior art references were trying to solve a different problem and hence could not be combined
- CAFC remanded the case for proper application of the TSM test i.e. “find a suggestion or motivation to attach an electronic control to a support bracket of the prior art assembly”
- Supreme Court grants certiorari





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# Supreme Court Analysis

- Supreme Court begins by rejecting a rigid application of the TSM test
- Reaffirms the Graham v. Deere analysis
- Cautions against granting patents based on a combination of prior art elements
  - “Combination of familiar elements according to known methods is obvious when it yields predictable results”
- Cautions against a formulaic approach to TSM
  - “The analysis need not seek out precise teachings directed to the specific subject matter of the challenged claims, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art will employ”
- Cautions against overemphasis on the importance of published articles and issued patents for an obviousness type rejection because “market demand, rather than scientific literature will drive design trends”



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# Supreme Court Analysis

- References may be combined:
  - “When work is available in one field of endeavor, design incentives and market forces can prompt variations of it either in the same field or a different one”
  - “Any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed”
  - “Obvious to try”: When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, then a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp
  - “Common sense’ approach where familiar items may have obvious uses beyond their primary purposes and a person of ordinary skill in the art will be able to fit the teachings of multiple patents like pieces of a puzzle”
  - A court may look at “effects of demands known in the design community or present in the market place; and the knowledge of those skilled in the art to determine if there was an apparent reason to combine prior art references





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# Supreme Court Analysis

- 103 rejections cannot be sustained by “mere conclusory statements” and there must be some articulated reasoning with some rational underpinning to support obviousness